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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,150	10/14/2004	Rudolf Waelti	2360-0421PUS1	9012
2292	7590	09/29/2006	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			LEE, HWA S	
			ART UNIT	PAPER NUMBER
			2877	

DATE MAILED: 09/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/511,150

Applicant(s)

WAELTI, RUDOLF

Examiner

Andrew Hwa S. Lee

Art Unit

2877

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/14/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 10-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. Many of the limitations are recited using different names for the same part. The examiner suggests the claims be reviewed for different names for the same element, clarifying if an element is an additional element, and clarifying if an element is being further defined. Below are *at least* some of the clarity issues.

4. It is unclear what is being claimed since Claim 10 appears to be a preamble in its entirety and is unclear as to what limitations are being claimed. In addition, the use of “preferably” is indefinite, and “said optical measuring device” lacks antecedent basis.

5. Claim 10 recites:

- a) a second optical fiber
- b) at least one second optical fiber and
- c) said second optical fiber

Are these referring to the same fiber?

6. In claim 14, is the image detecting element a CCD?

Art Unit: 2877

7. Claim 16 recites the second radiation in parenthesis. Is it an alternative or the same as “first part of said short-coherent radiation?” In addition it is unclear if the second part of radiation of said short-coherent radiation is the first radiation.
8. Claim 17 seems to be a duplicate recitation since the limitation has already been recited in claim 16.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

2114 [R-1] Apparatus and Article Claims - Functional Language

APPARATUS CLAIMS MUST BE STRUCTURALLY DISTINGUISHABLE FROM
THE PRIOR ART

While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

Many limitations found in claims 10-24 are functional limitations and these limitations can be met by the prior art if the structure of the prior art is capable of performing the claimed functions.

3. Claims 10-15 and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Podoleanu et al. (US 5,975,697) in view of Mori et al (US 6,476,919).

Podoleanu et al. (Podoleanu hereinafter) show an optical mapping apparatus with adjustable depth resolution having a modular configuration, said modular configuration having

a patient module (40, 6, 9, 10, 12),

an illuminating device providing short coherent radiation (50, 55, 57),

a first optical fiber (reference arm, 43),

an observation device (19,34) and a second optical fiber (measurement arm, 3, 4),

Art Unit: 2877

said patient module being positioned directly in front of the human patient's eye
(13) and being arranged remote from the evaluation unit (32),
said illuminating device being likewise arranged remote from said patient module,
said illuminating device producing a first radiation conductable with said first
optical fiber, the patient module having a first collimator (75, 77)
interacting with the first optical fiber,
said observation device being arranged in the patient module, said optical
measuring device having at least one second optical fiber guiding a
second radiation,
said patient module having a second collimator (6,10,12) said second collimator
converting said second radiation of said second optical fiber into a second
free-space beam,
a display (19),
a Michelson interferometer type,

Podoleanu does not expressly show the use of optical couplers that makes portions of the system modular. Mori et al show a reflectometer using connectors in the arms of the interferometer. At the time of the invention, one of ordinary skill in the art would have used connectors in the apparatus of Podoleanu in order to improve portability, ease repairs to portions of the apparatus, and allow flexibility in choosing elements for the apparatus. All these reasons are well known to a skilled artisan for the use of connectors. Furthermore, the use of electrical

Art Unit: 2877

connectors are also well known and would have been used for similar reasons as the optical connectors:

Furthermore, it has been held that rearranging parts of an invention and making an invention separable involves routine skill in the art. In re Japikse, 86 USPQ 70 and Nerwin v. Erlichman, 168 USPQ 177, 179.

4. Claims 16, 17, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Podoleanu in view of Mori et al as applied to claim 10 above, and further in view of Dogariu (US 6,256,102).

Podoleanu shows all the elements as discussed above and also shows the reference branch with two reflectors (two reflectors in the retroreflector), however Podoleanu does not use the two reflectors to divide the reference radiation.

Dogariu show a low-coherence Michelson interferometer wherein two reflectors (154, 158) are used in the reference arm of the interferometer. At the time of the invention, one of ordinary skill in the art would have produced a dual reference beam as shown by Dogariu in order to improved the signal-to-noise ratio by using both a collimated beam and a focused beam.

Allowable Subject Matter

5. Claim 18 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Art Unit: 2877

6. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record fails to show or to suggest an examination and/or treatment station having all the elements as presently claimed wherein an optical element in the reference branch covers said reflectors in succession with the second radiation.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Hwa S. Lee whose telephone number is 571-272-2419. The examiner can normally be reached on Tue-Fr.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory J. Toatley Jr. can be reached on 571-272-2800 ext 77. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Andrew Hwa Lee
Primary Examiner
Art Unit 2877